

Applicant : Copeland et al.
Serial No. : 10/816,199
Filed : March 31, 2004
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Attorney's Docket No.: 00565-069001

Amendments to the Drawings:

The attached replacement sheets of drawings includes changes to Figs. 1B, 1D, 2A, 3A, 3B, 3D, 6A, 6B, and 6C and replace the original sheets (pages 1, 2, 4, 5, 7 and 8) including Figs. 1A-1E, 2A, 3A-3B, 3C-4A, 6A-6B and 6C-7.

The changes to the drawings are shown on the attached Annotated Sheets and discussed in the applicant's Remarks below. No new matter has been added.

Attachments following last page of this Amendment:

Replacement Sheets (6 pages)
Annotated Sheet Showing Changes (6 pages)

REMARKS

Claims 1-9, 12-15 and 18-20 are pending. Claims 1-3, 5, 7, 9, 14 and 15 are amended. Claims 10, 11, 16 and 17 are cancelled. Claims 18-20 are new. No new matter is added. Claims 1, 2, 4, 5, 12 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,218,796 (Kozlowski). Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kozlowski in view of U.S. Patent No. 5,723,815 (Pena). Claims 3 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kozlowski in view of U.S. Patent No. 6,112,414 (Andis). Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kozlowski in view of U.S. Patent No. 2,625,455 (Mitten). Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kozlowski in view of U.S. Patent No. 2,617,702 (Manning). The applicant respectfully traverses the rejections and requests reconsideration in view of the amendments and remarks herein.

I. Objections to the Drawings

The Examiner made the following objections to the drawings which have been remedied by amending the drawings and/or specification as indicated below.

- Reference character 145 designates a microscope; any references to a cover panel have been amended in the specification and the drawings to refer to reference numeral 142.
- Reference character 180 designates a hanging clipboard; any references to a hanging storage bin in the drawings have been amended to refer to reference numeral 185, which is consistent with paragraph 0048 in the specification.
- Reference character 100 designates a storage unit; any references to the base have been amended in the specification and the drawings to refer to reference numeral 110.
- Reference character 315 has been removed from FIG. 3B.

The applicant trusts the amendments to the drawings and the specification remedy the Examiner's objections.

II. Objections to the Specification

The Abstract, paragraph 43, paragraph 51 and claim 5 have been amended to overcome the Examiner's objections to the specification.

III. The § 102 Rejections

Claims 1, 2, 4, 5, 12 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Kozlowski. Claim 1 recites an apparatus and reads as follows:

1. An apparatus, comprising:
 - a base and a top;
 - a plurality of receptacles between the base and the top, each of the plurality of receptacles configured to house a microscope, where the receptacles are arranged side by side one another forming one or more rows ;
 - a plurality of docking stations, where each of the plurality of docking stations is configured to receive a battery-powered microscope and to recharge the battery of the battery-powered microscope and is positioned within one of the plurality of receptacles;
 - an electrical cord electrically connected to the plurality of charging devices, the electrical cord including a plug configured to mate with an electrical outlet to supply electrical power to the plurality of charging devices; and
 - one or more wheels.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference" (*Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628 (Fed. Cir. 1987)). The applicant respectfully submits that claim 1 is not anticipated by Kozlowski. First, Kozlowski does not disclose an apparatus including a plurality of receptacles arranged side by side one another forming one or more rows, as required by the claim. By contrast, Kozlowski's device provides vertically arranged shelves configured for housing laptop computers. Second, Kozlowski does not disclose an apparatus including a plurality of docking stations where each docking station is configured to receive a battery-powered microscope and to recharge the battery of the microscope. By contrast, Kozlowski's device is directed toward laptop computers and discloses including a number of transformers in the device that can be connected by wire to the laptop computers (Col. 2, lines 41,42). There is no disclosure of a docking station that can receive a battery-powered device and

recharge the battery of said device. Accordingly, Kozlowski fails to disclose each and every limitation of claim 1, which is therefore not anticipated by claim 1.

The Examiner acknowledged that Kozlowski did not disclose a docking station in the Examiner's rejection of claim 3, and relied on Andis in that regard. Andis discloses a rechargeable hair clipper assembly. The assembly is suitable for receiving a single set of hair clippers and not integrated into any sort of storage unit for a plurality of battery-operated devices. The Examiner asserts it would have been obvious to combine the docking station of Andis with the storage cart of Kozlowski in order to provide a quickly coupled connection between said cart and the devices being recharged.

The applicant respectfully submits the Examiner has impermissibly used hindsight in an attempt to reconstruct the applicant's invention. It is improper to use the applicant's disclosure as the motivation to combine the particular teachings in the cited references: "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure". See, M.P.E.P. 2143, citing *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

Further, it is respectfully submitted that merely because prior art can be modified is not sufficient to render a claim *prima facie* obvious. See M.P.E.P. § 2143.01, which sets forth the applicable standard:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (*In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990)).

As held by the Court of Appeals for the Federal Circuit, in imposing a rejection under 35 U.S.C. §103, the Office Action must make a "thorough and searching" factual inquiry and, based upon that factual inquiry, explain why one having ordinary skill in the art would have been realistically motivated to modify the circuit design method to arrive at the claimed invention. See, *In re Lee*, 237 F.3d 1338, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). That burden has not been discharged.

The applicant respectfully submits that in any event it is not necessarily desirably to modify Kozlowski's laptop storage cart with docking stations. Docking stations are typically specific to a particular make and model of a laptop computer. By integrating such docking stations into Kozlowski's storage cart, the cart would be limited to use with only particular makes and models of computers. As laptop computers are constantly changing and being rendered obsolete, having a cart adapted to use with only one particular make and model may be considered undesirable. Accordingly, not only is there no motivation provided in the references for combining the rechargeable clipper docking station of Andis with the cart of Kozlowski, there are legitimate reasons why such a combination may not be desirable. The applicant respectfully submits a *prima facie* case of obviousness has not been established.

For at least the above reasons, claim 1 is not anticipated by Kozlowski and is patentable over Kozlowski in view of Andis. Claims 4, 9, 12 and 13 depend from claim 1 and are therefore allowable for at least the same reasons.

IV. The § 103 Rejections

Claim 6

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kozlowski in view of Pena. Claim 6 recites the apparatus of claim 1 further including a cord retractor configured to retract and house the electrical cord. The electrical cord is connected to the cord retractor and can be retracted into and at least partially housed within the cord retractor. As discussed above in reference to claim 1, Kozlowski does not disclose all of the limitations of the base claim 1. Accordingly, Kozlowski in combination with Pena also fails to disclose the limitations of claim 1 and claim 6. Claim 6 is therefore in condition for allowance.

Claims 3 and 7-9

Claims 3 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kozlowski in view of Andis.

Claims 7-9 depend from claim 1. As already discussed above, the base claim 1 is patentable over Kozlowski in view of Andis. Accordingly, claim 7-9 are allowable for at least the same reasons.

Claim 3 has been amended to depend from claim 14. Claim 14 recites an apparatus including a plurality of receptacles each configured to house a microscope and formed in a drawer slidable in a plane substantially parallel to the base and top of the apparatus. Claim 3 includes the further limitation that within each of the plurality of receptacles is a docking station for charging a microscope. Neither Kozlowski nor Andis, alone or in combination, disclose an apparatus including receptacles formed in a drawer and including docking stations. Accordingly, a *prima facie* case of obviousness has not been established and claim 3 is allowable over Kozlowski in view of Andis.

Claim 14

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kozlowski in view of Mitten. Claim 14 has been rewritten in independent form and reads as follows:

14. An apparatus, comprising:
 - a base and a top;
 - a plurality of receptacles between the base and the top and arranged side by side one another forming one or more rows, each of the plurality of receptacles configured to house a microscope, wherein each row of receptacles is formed in a drawer positioned between the base and the top and slidable in a plane substantially parallel to the base and the top, wherein the drawer is slidable between an open position wherein the openings of the plurality of receptacles are exposed and the corresponding interior regions are accessible and a closed position wherein the openings of the plurality of receptacles are not exposed and the corresponding interior regions are inaccessible;
 - a plurality of charging devices, where each of the plurality of charging devices is configured to recharge a battery of a battery-powered microscope and where each of the plurality of charging devices is positioned within one of the plurality of receptacles;
 - an electrical cord electrically connected to the plurality of charging devices, the electrical cord including a plug configured to mate with an electrical outlet to supply electrical power to the plurality of charging devices; and
 - one or more wheels.

As discussed above, Kozlowski discloses a device including a number of vertically arranged shelves configured to accommodate laptop computers. The Examiner acknowledges that Kozlowski does not disclose the use of drawers for storage of recharging devices, and relies on the Mitten reference in that regard. Mitten merely discloses a chest of drawers. The drawers

do not include receptacles arranged side by side and there are no charging devices included therein.

First, even in combination, Kozlowski and Mitten do not disclose the apparatus recited in claim 14, as neither disclose a plurality of receptacles arranged side by side and forming one or more rows.

Second, again, the applicant respectfully submits the Examiner has impermissibly used hindsight in an attempt to reconstruct the applicant's invention. It is improper to use the applicant's disclosure as the motivation to combine the particular teachings in the cited references: "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure". See, M.P.E.P. 2143, citing *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). Kozlowski clearly discloses a device having vertically arranged shelves. Although the concept of a chest of drawers was a well known concept at the time of Kozlowski's invention, Kozlowski did not disclose a device having drawers instead of shelves. The Examiner is using hindsight to modify Kozlowski's invention and the motivation for said combination is provided by the applicant's disclosure; this in impermissible use of hindsight.

The applicant respectfully submits a *prima facie* case of obviousness has not been established and claim 14 is in condition for allowance. Claims 2, 3 and 5 depend from claim 14 and are therefore allowable for at least the same reasons.

Claim 15

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kozlowski in view of Manning. Claim 15 has been rewritten in independent form and reads as follows:

15. An apparatus, comprising:
 - a base and a top;
 - a plurality of receptacles between the base and the top and arranged side by side one another forming one or more rows, each of the plurality of receptacles configured to house a microscope, wherein each row of receptacles is formed in drawer positioned between the base and the top, the drawer configured to pivot between an open position wherein openings of the plurality of receptacles are exposed and the corresponding interior regions are accessible and a closed position wherein the openings of the plurality of receptacles are not exposed and

the corresponding interior regions are inaccessible;

a plurality of charging devices, where each of the plurality of charging devices is configured to recharge a battery of a battery-powered microscope and where each of the plurality of charging devices is positioned within one of the plurality of receptacles;

an electrical cord electrically connected to the plurality of charging devices, the electrical cord including a plug configured to mate with an electrical outlet to supply electrical power to the plurality of charging devices; and one or more wheels.

As discussed above, Kozlowski discloses a device including a number of vertically arranged shelves configured to accommodate laptop computers. The Examiner acknowledges that Kozlowski does not disclose the use of drawers for storage of recharging devices, and relies on the Manning reference in that regard. Manning merely discloses a canister bin unit for food storage.

Again, the applicant respectfully submits the Examiner has impermissibly used hindsight in an attempt to reconstruct the applicant's invention. It is improper to use the applicant's disclosure as the motivation to combine the particular teachings in the cited references: "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure". See, M.P.E.P. 2143, citing *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). Kozlowski clearly discloses a device having vertically arranged shelves. Although the concept of a bins was a well known concept at the time of Kozlowski's invention, Kozlowski did not disclose a device having a pivotable drawer instead of shelves. The Examiner is using hindsight to modify Kozlowski's invention and the motivation for said combination is provided by the applicant's disclosure; this is impermissible use of hindsight.

The applicant respectfully submits a *prima facie* case of obviousness has not been established and claim 15 is in condition for allowance. Claims 18-20 depend from claim 15 and are therefore allowable for at least the same reasons.

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Enclosed is a \$60 check for the Petition for Extension of Time fee. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date:

7 April, 2006

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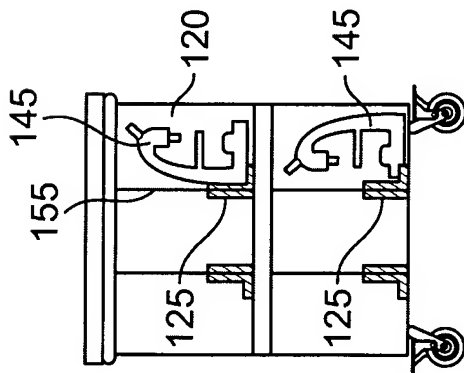


FIG. 1A

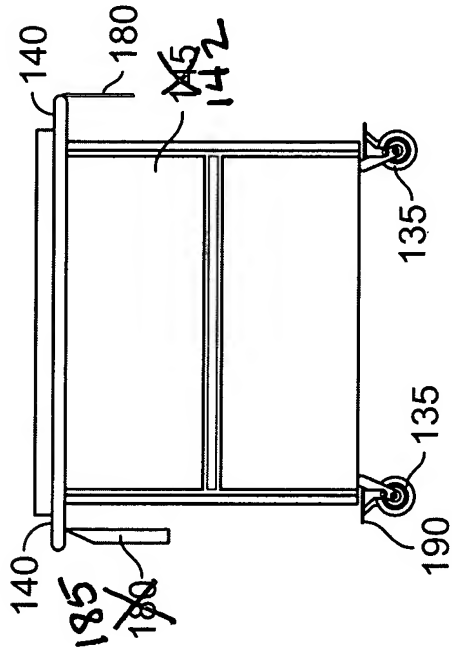


FIG. 1B

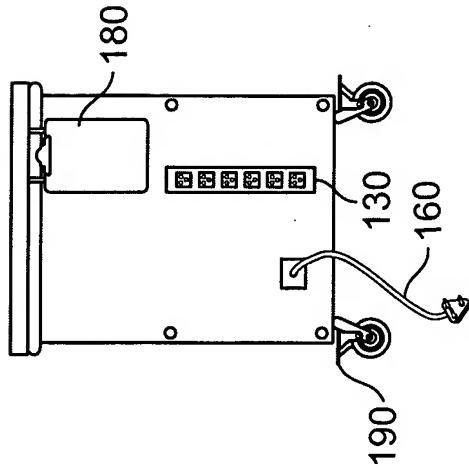


FIG. 1C

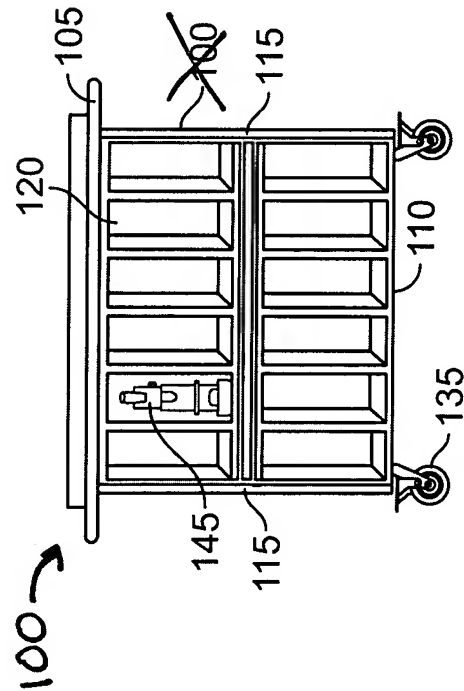


FIG. 1D

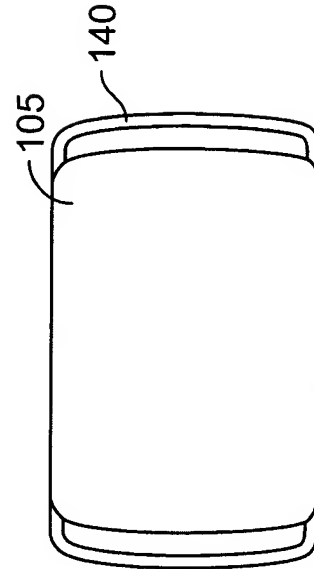


FIG. 1E

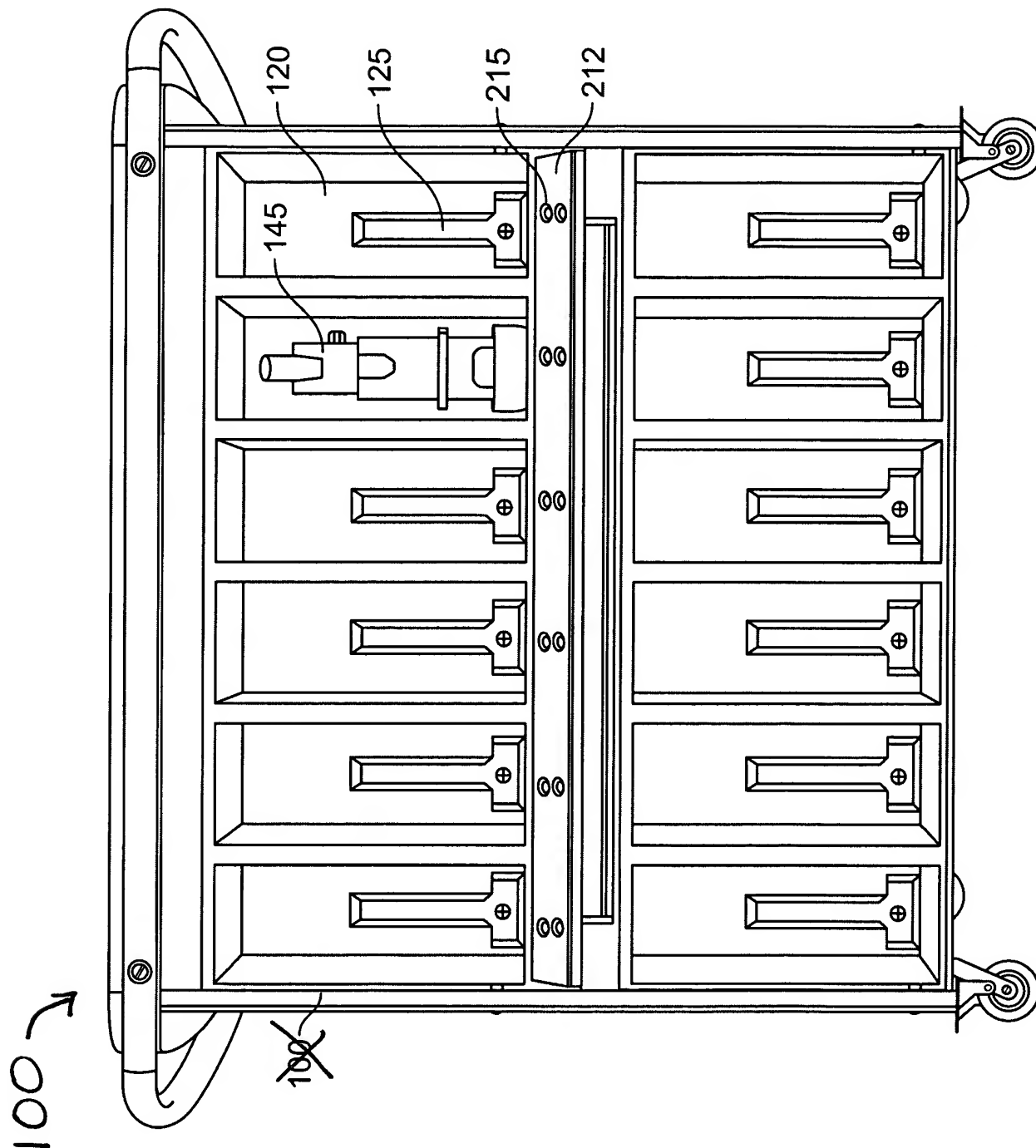


FIG. 2A

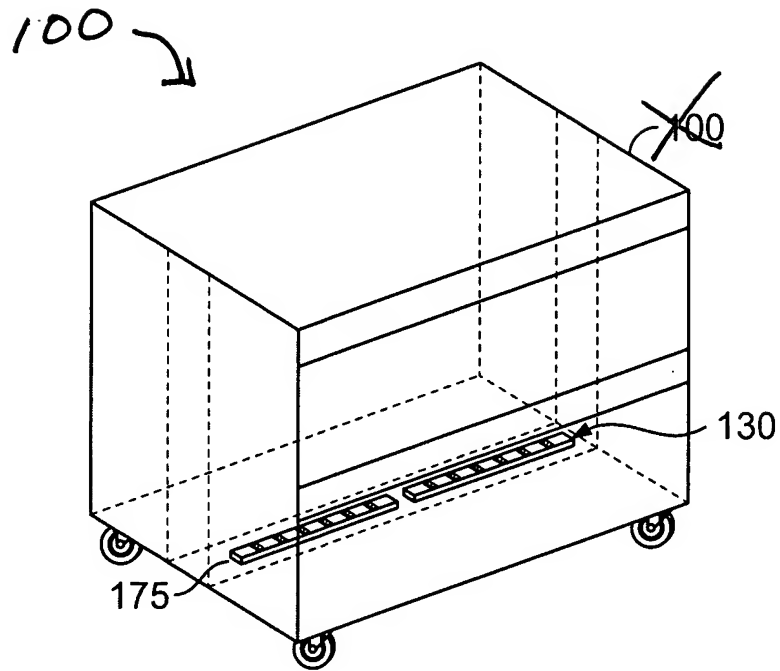


FIG. 3A

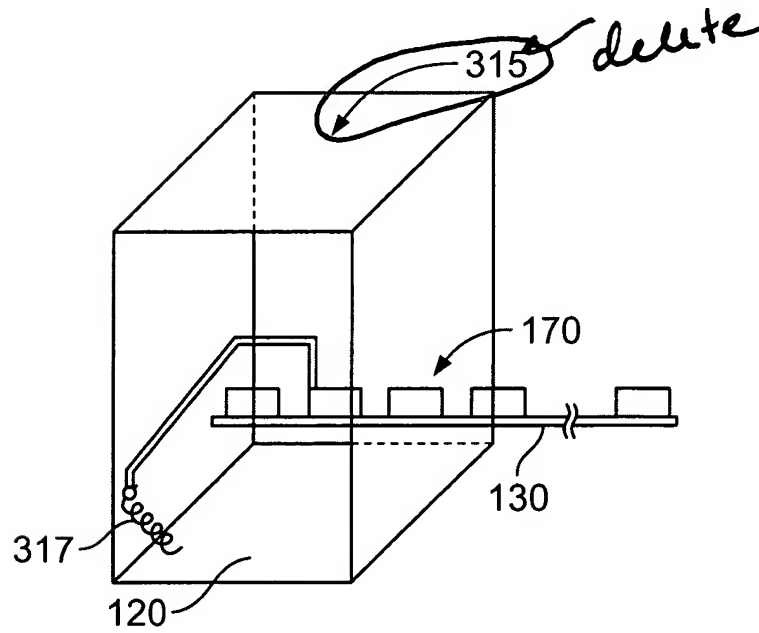


FIG. 3B

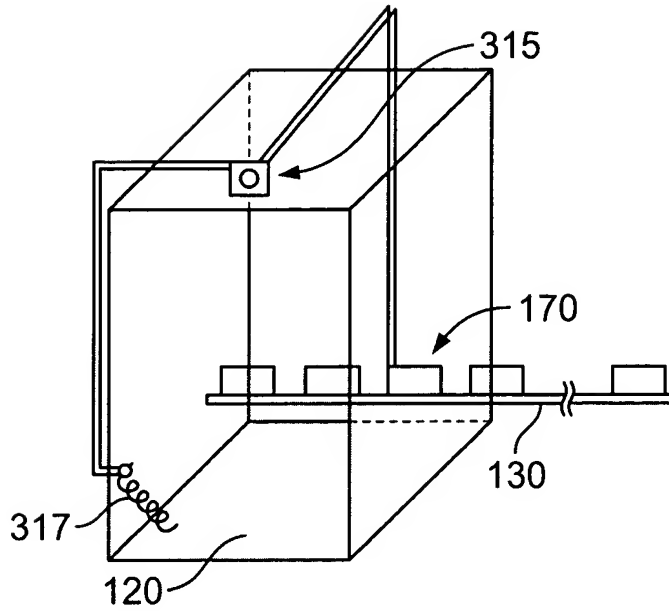


FIG. 3C

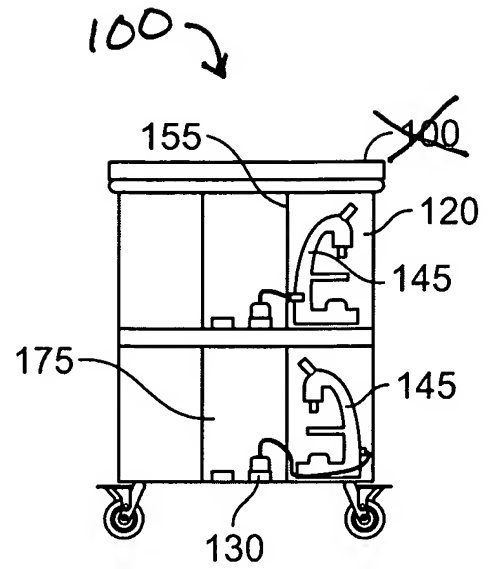


FIG. 3D

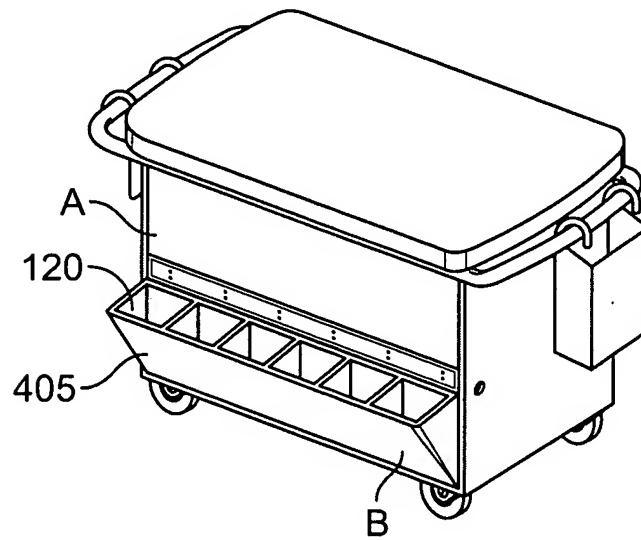


FIG. 4A

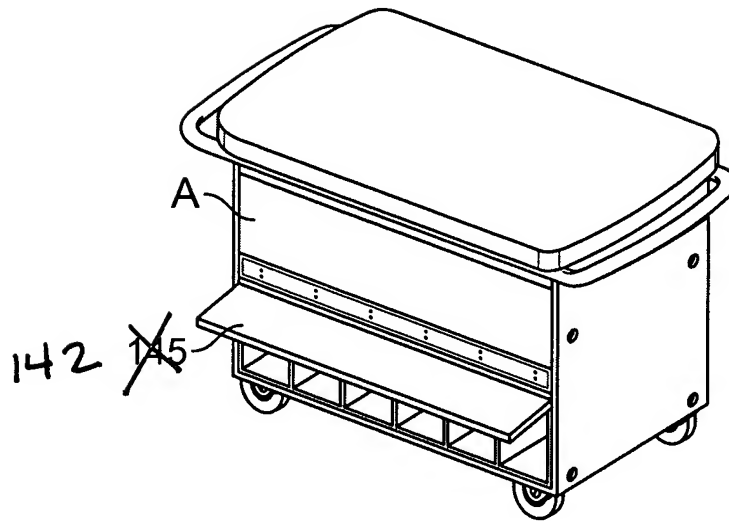


FIG. 6A

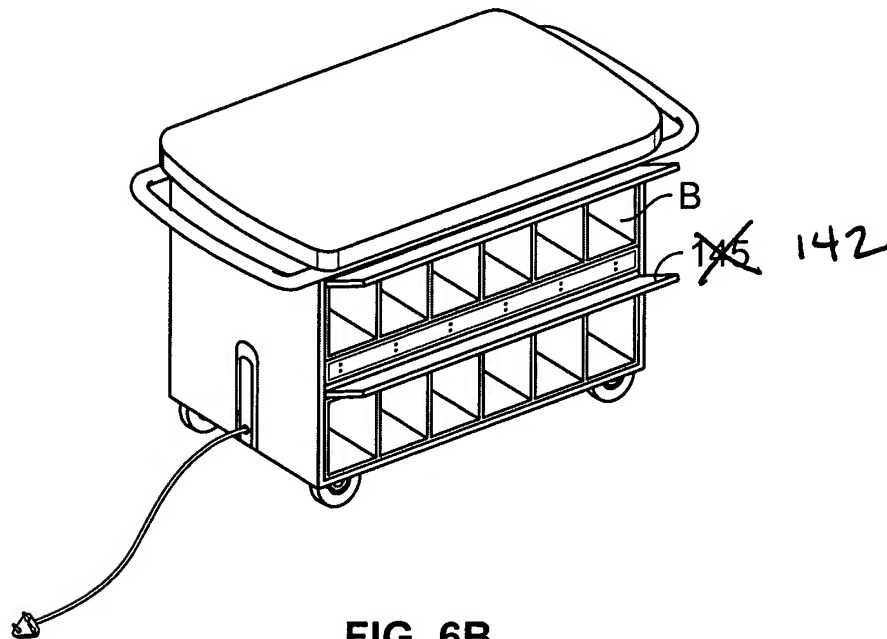


FIG. 6B

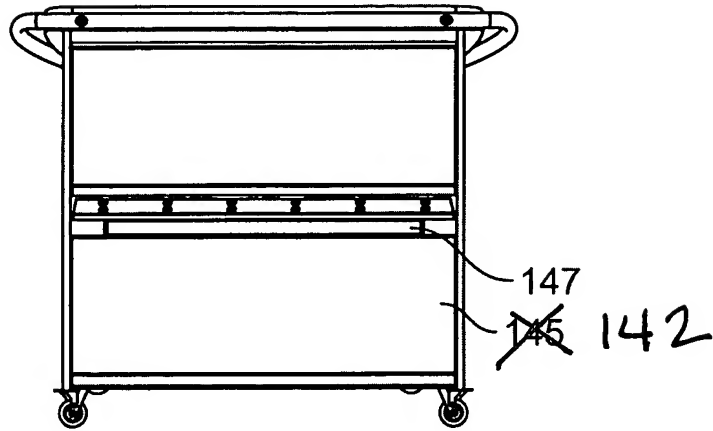


FIG. 6C

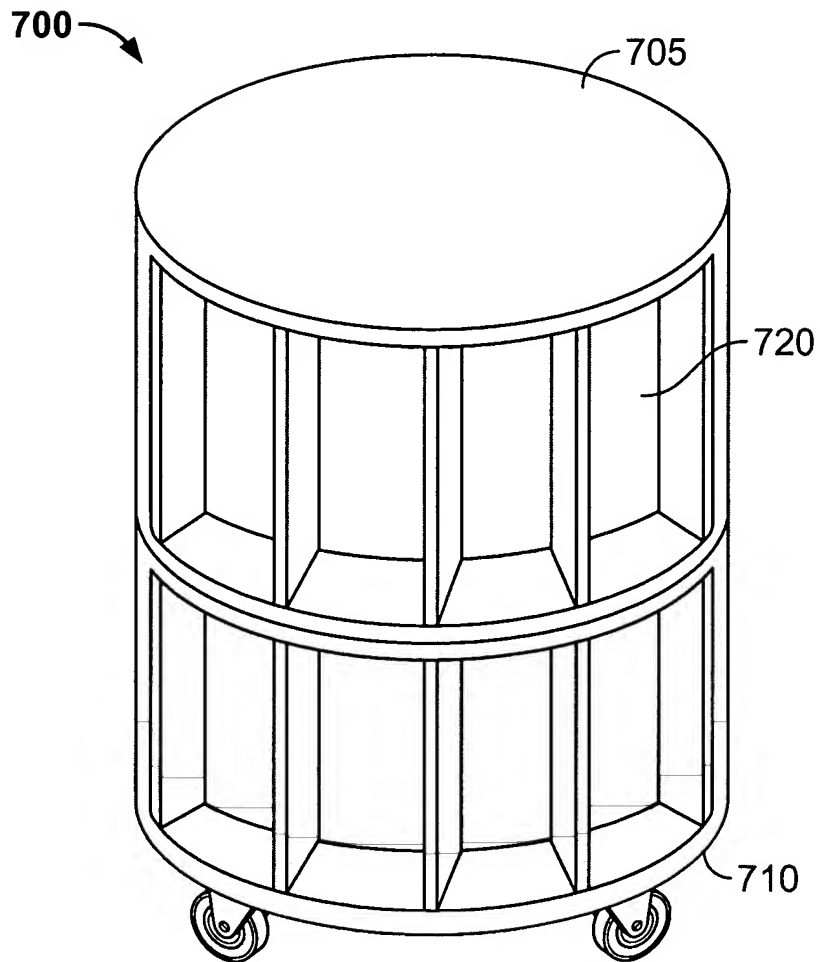


FIG. 7